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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,117	09/29/2001	Robert D. Dickinson III	TUMB-102 CON2	9177

26137 7590 05/23/2003

PATENT DEPARTMENT  
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP  
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NEW YORK, NY 10036

EXAMINER
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CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/967,117

Applicant(s)

DICKINSON ET AL.

Examiner

Paul E. Callahan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-15 are pending in this application and have been examined.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shewd, US Patent 5,606,668.

As per claim 7, Shewd teaches a method for controlling e-mail message transmission across an e-mail firewall, the e-mail firewall interposed between an internal network and external networks (abstract), the method comprising: intercepting a message from a sender associated with the internal network to a recipient associated with an external network; filtering the message by examining content associated with the message by employing user defined content filter conditions of the e-mail firewall; and restricting the transmission of the message in accordance with the results of said filtering (col. 1 lines 59-67 and col. 2 lines 1-60).

As per claim 15, Shewd teaches restricting the transmission includes routing the message in accordance with user defined routing policies (fig. 3A "Destination" column definitions of Graphical User Interface).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landfield, US Patent 5,632,011, Bruce Schneier: Applied cryptography 2<sup>nd</sup> Edition, Oct. 1995, John Wiley & Sons Pub., and Official Notice taken as detailed below.

As per claim 1, Landfield teaches a method for transmitting a message between a sender associated with a first email firewall and a recipient associated with a second e-mail firewall, the method comprising: intercepting a message from the sender intended for the recipient (abstract); searching an encryption directory for an entry associated with the recipient (col. 4 lines 25-45); retrieving an encryption key associated with a second firewall, the second firewall associated with the recipient; encoding the message and allowing the message to proceed through the firewall (fig 2a, b, c). Landfield does not explicitly teach encrypting with an encryption key associated with the second e-mail firewall to provide an encrypted message, however Official Notice may be taken that such a step is old and well known in the art of public key cryptosystems for example. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Landfield. It would be desirable to do so as this would increase the security of the communications system.

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As per claim 2, Landfield does not explicitly teach encoding the message is by employing an encryption key that is stored locally by the first e-mail firewall however such is taught implicitly by fig. 2c items 52 and 54 where a message is received in encrypted form.

As per claims 3 -5, Landfield does not teach encoding the message is by employing an encryption key that is retrieved from an external server over a secure data link that employs a locally stored encryption key associated with the external server. However Schneier teaches such, pages 185-187: "Public Key Management" Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Schneier into the system of Landfield. It would have been desirable to do so as this would decrease storage overhead at the firewall.

As per claim 6, Landfield teaches a method for receiving a message from a sender associated with a first e-mail firewall and ultimately allowing the message to proceed through the firewall to the recipient, but does not teach the first e-mail firewall encoding the message by using an encryption key of the second e-mail firewall, comprising: intercepting the message; by the second e-mail firewall; decoding the message with a private key of the second e-mail firewall. Schneier does teach these steps at pages 31-33 and 185-187. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Schneier into the system of Landfield. It would have been desirable to do so as this would decrease storage overhead at the firewall.

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6. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shewd as applied to claim 7 above, and further in view of Landfield, Hershey et al., US Patent 5,414,833 and Official Notice taken as detailed below.

As per claims 8-10, Shewd does not teach said filtering is by parsing the text of the message in accordance with said filter conditions, or said parsing of text is by searching for keywords in the text, or said parsing of text is by searching for word patterns in the text. Hershey does teach such parsing operations (abstract, col. 2 lines 55-68, col. 6 lines 1-44, and col. 5 lines 20-51). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Shewd. It would have been desirable to do so as this would increase the security of the e-mail messaging system.

As per claim 11, Shewd does not explicitly teach said filter conditions employ Boolean expressions, however Official Notice may be taken that such filtering via Boolean logic is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Shewd. It would have been desirable to do so as this would increase the security of the e-mail messaging system.

As per claim 12, Shewd does not teach said filtering conditions include rejecting all executable attachments, however Landfield does teach this (col. 51-60). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Shewd. It would have been desirable to do so as this would increase the security of the e-mail messaging system.

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As per claims 13 and 14, Shewd teaches said filtering conditions include requiring executable attachments to include digital signatures and filtering based on reference to a directory of trusted signatures (fig. 3A "Trusted Parties").

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 Official Faxes, (703) 746-7240 Unofficial Faxes, and (703) 746-7238 After Final Faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

5-13-03

Paul Callahan

[F]filtering the message by examining content associated with the message by employing [user defined] content filter conditions of the e-mail firewall to provide a filtering result; and

[R]restricting the transmission of the message in accordance with said [the] result[s of said filtering].